

### **REMARKS/ARGUMENTS**

By this Amendment, claims 1-28 are canceled, and claims 29-110 are added. Claims 29-110 are pending.

Citations to the Specification are directed to U.S. Patent Application Publication No. 2007/0111980 (Bandi Parthasaradhi Reddy et al.).

Support for the new claims can be found throughout the Specification as filed, and specifically: support for the limitation wherein the compound comprises  $\Delta 2$  isomer in less than about 10% of the compound, less than about 3%, and less than about 0.4%, can be found in ¶[0034].

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

#### **Rejections under 35 USC 112 second paragraph**

Claims 1-28 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Examiner argues that the term "substantially free" is indefinite, allegedly because terms of degree, such as "substantial" are indefinite when the specification lacks "explicit guidelines" to distinguish from things which are not so, Ex parti Oetiker, 23 USPQ2d 1651, 1655 (1990), and Seattle Box v. Industrial Crating, 221 USPQ 568, 574.

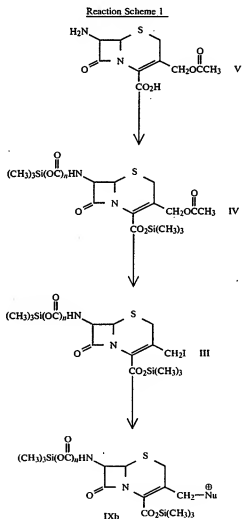
Without acquiescing to the propriety of the Examiner's rejection, and solely in an effort to advance prosecution, Applicant has presented the new claims, which set forth the concentration of the  $\Delta 2$ isomer.

It is respectfully submitted that the claims presently pending in this application comply in all respects with the requirements of 35 U.S.C. § 112, second paragraph and that the rejection based on this section of the patent statutes should be withdrawn.

The Examiner argues that the (OCO)n structural piece is unclear. However, in reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph "by

providing clear warning to others as to what constitutes infringement of the patent". See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). MPEP 2173.02, MPEP 2173.02. In the instant case, the skilled artisan is apprised of the metes and bounds of the claims.

The Specification discloses that U.S. Pat. No. 4,868,294, sets forth that the key intermediates substantially free of  $\Delta 2$  Isomer can be prepared (see ¶[0008]). U.S. Pat. No. 4,868,294 (cited on the IDS submitted June 19, 2006) discloses the structure of the (OCO)<sub>n</sub> structural piece as recited in the instant claims (e.g., see U.S. Pat. No. 4,868,294, at column 10):



Application No. 10/565,086  
Amendment Dated 8/13/2009  
Reply to Office Action of 02/17/2009

The test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). MPEP 2173.02.

Here, one of ordinary skill in the art would understand what is claimed, given the teachings of the Specification, the claim as written, and the knowledge in the art. It is submitted that the claims are definite. Reconsideration and withdrawal of the rejection is respectfully requested.

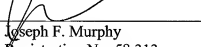
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For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Please charge or credit our  
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